

Application No. 10/521685

Reply to Final Office Action dated March 4, 2009

REMARKS

Applicant respectfully requests favorable reconsideration and reexamination of this application.

Claim 1 has been revised editorially, wherein the term "positioning portions" has been replaced with "positioning recesses." Claim 1 has been revised to include features of claim 13. Revisions to claim 1 are also supported by, for example, line 2 of page 7, lines 1-4 of page 11, and Figs. 1-5 in the Specification. Claims 5-6, 10-12, and 15-16 have been revised editorially to track with claim 1, from which they depend. Claim 13 has been canceled to track with the revision. Claim 14 has been revised to depend on claim 1 to track with the canceled claim 13. Revision to claim 14 is supported by, for example, lines 7-8 of page 8, and Figs. 2 and 4 in the Specification. There is no new matter. Claims 1, 3-6, 8-12, and 14-17 are pending.

Final Rejection is Improper

It is patently unfair to the Applicant when the Examiner does not properly communicate the basis for a rejection so that the issues can be identified early and the applicant given a fair opportunity to reply to the rejection. In the present application, the rejection being final is unfair to the Applicant.

- In the Office Action dated November 8, 2007, the Examiner stated that claims 7-12 would be allowable if rewritten in independent form.
- In response, Applicant filed an Amendment on May 8, 2008, canceling claim 7 and revising claim 1 to recite the features of claim 7 with the expectation that such a revision would make claim 1 and its dependent claims allowable.
- In the Office Action dated August 7, 2008, claim 1 was rejected as being based on a disclosure which was not enabling.
- Claim 1 was revised to address this issue in the Amendment filed on February 6, 2009 with the expectation that such a revision would make claim 1 and its dependent claims allowable. The revision did not broaden the scope of the claim. Accordingly, the Applicant reasonably expected the claim would be allowed based on the prior statements from the Examiner.
- In the final Office Action, claim 1 has been rejected based on a newly cited reference.

Application No. 10/521685

Reply to Final Office Action dated March 4, 2009

- Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office Action is proper, providing that:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement....

Applicant respectfully submits that because the features added to independent claim 1 were presented for examination in the preceding Office Actions, the new ground of rejection of claim 1 made in the final Office Action cannot reasonably be said to be either necessitated by a claim amendment or an Information Disclosure Statement.

Further, Applicant respectfully submits that the revisions to claim 1 were in furtherance of advancing the prosecution as indicated by the Examiner's statements in the preceding Office Actions.

Thus, it is unfair to the Applicant, to be told in a preceding Office Action that a claim would be allowable if rewritten in independent form, and when the Applicant responds with such a revision, the claim is finally rejected based on a newly cited reference claiming that the Applicant's amendment necessitated the new grounds for the rejection.

Applicant has not been given a fair opportunity to reply to the rejection. The final rejection is improper. The finality of the Office Action should be withdrawn.

Claim Rejections – 35 USC § 102

Claims 1, 3-6, 8-12 and 15-17 were rejected under 35 USC 102(b) as being anticipated by Vandenberg et al. (US 3709598). Applicant does not concede the correctness of the rejection. Claim 1 has been revised to recite the features of claim 13. Claims 3-6, 8-12 and 15-17 depend on claim 1. Thus, this rejection is moot. Applicant respectfully requests that this rejection be withdrawn.

Claim Rejections – 35 USC § 103

Claims 13-14 were rejected under 35 USC 103(a) as being unpatentable over Vandenberg et al. in view of JP 06/323997 (hereafter Tanzawa; Applicant respectfully brings to the Examiner's attention that JP 06/323997 names Kazuhiko Tanzawa as the inventor, wherein

Application No. 10/521685

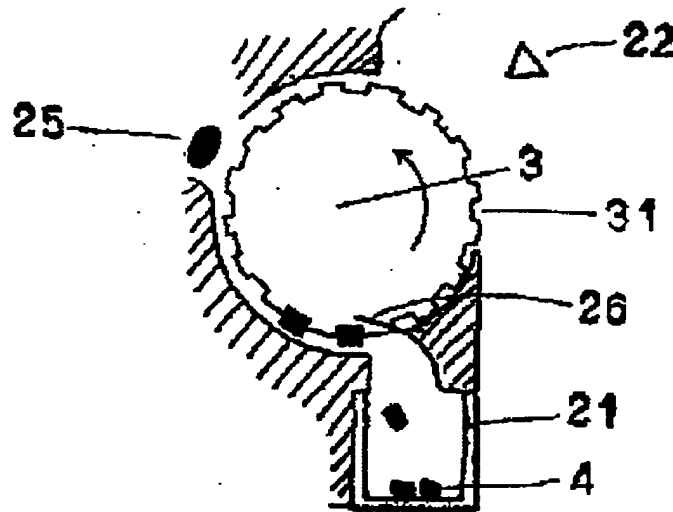
Reply to Final Office Action dated March 4, 2009

Kazuhiko is the first name and Tanzawa is the last name). Applicant respectfully traverses this rejection.

Claim 13 has been canceled. Features of claim 13 are recited in claim 1. Accordingly, this rejection is addressable with respect to claim 1.

The rejection conceded that Vandenberg et al. fails to teach a blade. The rejection conceded that Vandenberg et al. fails to teach a guide portion on the rotating body for allowing the blade to move relative to the rotating body. The rejection stated that Tanzawa remedies these deficiencies. Applicant respectfully disagrees.

Tanzawa does not teach a blade that is inserted between the target analyte and a bottom of the positioning recess for removing the target analyte held in the positioning recess. Tanzawa teaches a discharge guide 26 provided in the tray connecting end of the device main frame 2 that hooks the end of the test tool 4, and the test tool 4 is discarded one by one into the abandonment box 21 (paragraph [0017] of English translation of Tanzawa; also see Fig. 5).



Tanzawa, Fig. 5

As shown above, Tanzawa teaches a discharge guide 26 that merely pushes the edge of the test tool 4. The discharge guide 26 does not and cannot be inserted between the test tool 4 and the bottom portion of the recesses. Thus, Tanzawa does not teach a blade that is inserted between the target analyte and a bottom of the positioning recess for removing the target analyte held in the positioning recess

Application No. 10/521685

Reply to Final Office Action dated March 4, 2009

Accordingly, even if the teaching in Tanzawa is combined with the device according to Vandenberg et al., which Applicant is not conceding that they are combinable, such a combination still fails to teach all of the features of claim 1.

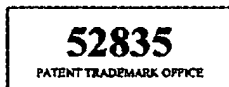
Further, Vandenberg et al. teaches that the gelatin capsules “must be as free as possible of imperfections...especially to provide proper operation of the machines in which they are filled, to avoid waste and improper dosage of the medicinal material, and to avoid production of imperfect filled capsules” (column 1, lines 31-36). Vandenberg et al. teaches that imperfections include defects such as “split or cracked capsules, capsules with holes or notches in their wall, mashed or flattened capsules, telescopically deformed capsules, cutting encircling or otherwise attached to the capsules, incomplete capsules, crimps, turned edges on the caps, black specks, dents, bubbles, depressed ends, ragged edges on the cap, scrapes, pin marks, thin spots, etc.” (column 1, lines 58-64). To avoid further causing these imperfections to the capsules, Vandenberg et al. teaches a device that includes a pressurized means for removing the capsules, instead of a device that makes direct contact with the capsules. In contrast, the discharge guide taught in Tanzawa makes direct contact with the test tools. Tanzawa teaches that the discharge guide “hooks the end of the test tool 4” (paragraph [0017], English translation). Thus, replacing the pressurized means of Vandenberg’s device with the discharge guide taught in Tanzawa would cause the discharge guide to directly “hook the ends” of the capsules. Such direct contact would likely cause defects and imperfections on the capsules. Vandenberg et al. requires that the capsules “must be as free as possible of imperfections” (column 1, line 31). Thus, combining the discharge guide of Tanzawa with the device according to Vandenberg et al. would render Vandenberg’s device from working as originally intended. Further, there is no motivation to combine a device that can cause imperfections to capsules, such as the discharge guide according to Tanzawa, to a device requiring that capsules must be free of imperfections. Therefore, it would not be obvious to one skilled in the art to combine the discharge guide according to Tanzawa with Vandenberg’s device. For at least the above reasons, claim 1 is patentable over Vandenberg et al. in view of Tanzawa.

Regarding claim 14, Vandenberg et al. in view of Tanzawa fails to teach a rotating body including a guide recess located between each two adjacent positioning recesses for allowing the blade to move relative to the rotating body in intimate contact therewith. Therefore, claim 14 is patentable over Vandenberg et al. in view of Tanzawa.

Application No. 10/521685
Reply to Final Office Action dated March 4, 2009

Claims 3-6, 8-12, and 14-17 are patentable for at least the same reasons as claim 1 from which they depend. Applicant respectfully requests a favorable reexamination and reconsideration of the claims.

In view of the above, early issuance of a notice of allowance is solicited. Any questions regarding this communication can be directed to the undersigned attorney, Douglas P. Mueller, Reg. 30,300, at (612)455-3804.



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Respectfully submitted,

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